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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
TESKIN, FRED M

ART UNIT	PAPER NUMBER
1713	13

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-13

Office Action Summary	Application No. 09/807,842	Applicant(s) Terano, et al.
	Examiner Fred Teskin	Art Unit 1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three (3)* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Apr 7, 2003*.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-54* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) *25-31* is/are allowed.

6) ☒ Claim(s) *1-24 and 32-54* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1. Amendments presented in the Response of 07 April 2003 are acknowledged. Claims 1-54 are currently pending and under examination.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in

> the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-24 and 32-54 stand rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Terano et al 6211300 ("Terano").

Terano exemplifies propylene-ethylene block copolymer compositions (E) which contain an A-B type block copolymer (C) of polypropylene (A) and an ethylene-propylene random copolymer (B) and a propylene polymer (D), and wherein the content of said copolymer segment and the total ethylene content [(C) plus (D)] meet the corresponding parameters of claim 1. In addition, Terano states that the segment (B) is chemically bonded to the polypropylene segment (A), per characteristic (a) of claims 1 and 18, 32 and 49, and describes a procedure for synthesizing the (A) and (B) segments which corresponds to that recited as characteristic (b) of said claims. See column 2, lines 41-44; Examples 1-13 and Tables 1-5.

In addition, the total ethylene content of the polypropylene (A) and ethylene-propylene random copolymer (B) segments of the exemplified block copolymers falls within the weight % range specified in claim 18 for total ethylene content of polypropylene-

b-poly(ethylene-co-propylene) (see, e.g., (B) segment ethylene content given for Examples 1-3 in Table 1 of Terano).

As to the claimed parameters of M_w, M_w/M_n and xylene-soluble component, Terano does not report these properties for the block copolymer compositions described therein.

Nevertheless, in view of the identity in block copolymer composition and synthesis procedure, examiner has reasonable basis to believe the disclosed compositions are same as, or only slightly different from, applicants' block copolymer and resin as claimed.

Where as here there is reason to believe the property or characteristic relied upon for patentability may be inherent in the prior art, the burden properly shifts to applicants to show that the property or characteristic recited in the claims represents an unobvious difference. *In re Best*, 195 USPQ 430 (CCPA 1977).

5. Applicants' arguments filed 07 April 2003 have been fully considered but are not persuasive of error in the repeated rejection.

Inviting reference to the designations for I and II on page 1 of their specification, applicants contend the polymers of the present invention do not contain the polypropylene polymer (D) of the block copolymer composition of Terano and are not a polymer composition.

Examiner disagrees that the rejected claims are so limited as to exclude the presence of the polypropylene polymer (D) of the Terano block copolymer composition.

Indeed, referring to designations I to III as more specifically set out on page 31 of the present specification, it becomes apparent that the claimed polymers are intended to include, *inter alia*, synthetic resins that "may be added singly or in combination of two or more species" (*id.*, third full sentence).

Clearly the polypropylene polymer (D) of Terano qualifies as a "synthetic resin," which is effectively added to Terano's A-B block copolymer (C) by performing polymerization step d) in the presence of that block copolymer. Moreover, said polymer (D) is not excluded from the claimed subject matter in view of the open transitional language: "... block copolymer *comprising*" (claim 1); "... block copolymer *containing*" (claim 11); "... propylene resin for molding *containing*" (claim 18); "... molded article formed by a molding a propylene-ethylene block copolymer *containing*" (claims 32 and 42); and "... molded article formed by a molding a ... polypropylene resin for molding *containing*" (claim 49).

The law of anticipation does not require that the reference teach what the applicants are claiming, but only that the claims

"read on" something disclosed in the reference. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 781, 789 (Fed. Cir. 1983).

Instantly, the rejected claims are readable on the composition of Terano because when read in light of the supporting disclosure and given their inclusive language, they are properly construed as open to addition of various synthetic resins to the recited block copolymer, including the polypropylene polymer (D) of Terano.

6. Claims 1-17 and 32-54 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention.

Evidence that claims 1-17 and 32-54 fail to correspond in scope with that which applicants regard as the invention can be found in the Response of 07 April 2003. In that paper, applicants have stated, "... the reference does not disclose or suggest molded articles formed by molding a propylene-ethylene block copolymer *consisting of* polypropylene-b-poly(ethylene-co-propylene) of the present invention ..." (*Id.*, page 10, penultimate paragraph; emphasis added). Use of the closed "consisting of" language in describing the propylene-ethylene block copolymer of the present invention indicates that the invention is different from what is defined in the claims, because in claims 1-17 and 32-54, the

propylene-ethylene block copolymer is claimed using inclusive language; i.e.,"[a] propylene-ethylene block copolymer *containing* polypropylene-b-poly(ethylene-co-propylene)..." and "[a] molded article formed by molding a propylene-ethylene block copolymer *containing* polypropylene-b-poly(ethylene-co-propylene)...". (Claims 1, 11, 32, 42 and 49, lines 1-2 of each; emphasis added.)

7. Claims 25-31 stand allowed on the present record.

8. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the

statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (703) 308-2456.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (703) 308-2450. The appropriate fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 (non-after finals) and (703) 872-9311 (after-finals).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

FMTeskin/06-18-03

FRED TESKIN
PRIMARY EXAMINER
1713